

5598-9
Serial No.: 10/625,082REMARKS

Claims 1-39 are pending in the above-identified application. By this Amendment, Applicant has amended claims 1, 24, 25, 32, 35, and 36, and has cancelled claims 2-3. The amendments to the claims are supported by the application as originally filed, and do not introduce new matter. Accordingly, entry of the amendments is respectfully requested.

Claim Rejections – 35 U.S.C. §101

The Examiner rejects claim 1-35 under 35 U.S.C. §101 asserting that “the bodies of these claims do not recite technology, i.e., computer implementation or any other technology.” The Applicant has amended claim 1 to recite “A computer implemented method” and “allowing transactions in a set of one or more instruments on a networked computer system.” Claim 1 and claims 4-32 dependent thereon as amended therefore recite technology in the body of the claims. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

With respect to claims 33-35, the Applicant respectfully traverses the rejections. Claims 33-35 are directed to a networked computer system that includes at least one client computer and at least one server computer, which satisfies any computer implementation in the body of the claims requirement contrary to the Examiner’s assertion. Similarly, claim 34 is directed to a computer readable medium, which is not merely an algorithm or an abstract idea. A computer readable medium, such as a disc, tape, etc., is a physical item within the technological arts. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Claim Rejections – 35 U.S.C. §112First Paragraph

The Examiner rejects claims 1-39 under 35 U.S.C. §112 first paragraph, asserting that the specification “does not reasonably provide enablement for the transaction” and that “technical steps required to illustrate the details of how the transaction is implemented are missing.” The Examiner further provides that “the explanation of how the invention actually works and is implemented does not clearly enumerate enough details to enable recreation of the invention by one of ordinary skill.” The Applicant respectfully traverses the rejections.

5598-9

Serial No.: 10/625,082

The enablement requirement of 35 U.S.C. §112 requires that the specification describe the invention in such detail that one skilled in the art may be able to make and use the claimed invention. MPEP 2164. "Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention." *Id.* "The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." MPEP 2164.01 citing *United States v. Telectronics, Inc.*, 857 F.2d at 778, 785 (Fed Cir. 1988).

The pending claims recite the term transaction contextually with the term instruments. Thus, a transaction includes any process that can involve the claimed instrument. An instrument is associated with a concept, which includes computer searchable terms, which instrument is valued based on the value of the concept. The Examiner admits that instrument valuation is enabled. The Examiner can appreciate that, in this context, the number of possible processes in the set of transactions that can involve a valued instrument is not infinite. The specification provides a number of examples of transactions that may involve the instruments of the present invention, including buying, selling, exchanging, trading, hedging, speculating, forecasting, data generating, etc. See page 10, lines 9-11 and page 32, line 2 to page 33, line 22. Moreover, claim 9 provides that transactions include buying and selling the instruments and claims 17-18 provide that transactions are betting transactions that relate to the present or future value of the concepts.

The Applicant notes at page 10, line 11 of the specification that "electronic and computerized trading systems and markets [that implement such transactions] are known in the art." The Applicant further incorporates by reference the disclosure of 21 issued U.S. Patents that provide sufficiently detailed steps for implementing many of the above-identified transactions, including the buying and selling transactions per claim 9. See page 10, lines 9-23. Therefore, the specification provides the details for one skilled in the art to reproduce the present invention with the disclosure of the incorporated references. Moreover, to the extent the incorporated references may not provide specific details for any one of the above-identified transactions, these transactions are well known and one skilled in the art is able to reproduce the invention without undue experimentation, given the level of skill in the art and the scope of the claims. The Applicant notes that "the patent does not need to teach, and preferably omits, that which is well known in the art." *Id.* citing *In re Buchner*, 929 F.2d 660,

5598-9

Serial No.: 10/625,082

661 (Fed. Cir. 1991). Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Moreover, the Examiner has a duty to "establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*." MPEP 2106.01 *citing in re Brown*, 477 F.2d 948 (CCPA 1973). "To establish a reasonable basis for questioning the adequacy of a disclosure, the examiner must present a factual analysis of [the] disclosure to show that a person skilled in the art would not be able to make and use the claimed invention without resorting to undue experimentation. MPEP 2106.02. The Examiner rejects all of the claims under 35 U.S.C. §112 first paragraph without a factual analysis and does not provide any reasoning as to how those skilled in the art cannot reproduce the invention without undue experimentation. The Examiner rejects all of the pending claims with mere conclusory statements regarding the adequacy of the specification. The Applicant respectfully requests that the Examiner provide a factual analysis of the present disclosure with reference to the scope of each of the pending claims and the reasoning as to why undue experimentation is required. Otherwise, the Applicant requests that the Examiner withdraw the rejection.

Second Paragraph

The Examiner rejects claims 1-39 under 35 U.S.C. §112, second paragraph, asserting that the claims are "incomplete for omitting essential elements, essential steps and essential structural cooperative relationships of elements, such omission amounting to a gap between the elements." The Examiner asserts that the essential elements omitted are "the exact steps needed to implement the invention so that it can be re-created by one of ordinary skill" and that the claims are too broad insofar as they "do not indicate how the value of the instruments are established based on the associated one or more concepts. The Applicant respectfully traverses the rejections.

MPEP 2172.01 provides that "[a] claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. §112, first paragraph, as not enabling." MPEP 2164.08(c) further provides that such a rejection "should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as

5598-9

Serial No.: 10/625,082

intended.” “Broad language in the disclosure ... omitting an allegedly critical feature tends to rebut the argument of criticality.” *Id.*

It appears that the Examiner may have erred in rejecting the pending claims under the 35 U.S.C. §112, second paragraph. To the extent this is true, the Applicant requests that the Examiner withdraw the rejection under 35 U.S.C. §112, second paragraph. Moreover, the pending claims do not omit any essential elements or critical features of the invention. There is no language in the specification or in any statements of record to indicate that the manner in which the value of the instrument is established is an essential element or a critical feature of the invention. Indeed, the specification describes the invention with regard to the valuation of an instrument in the broadest sense. For instance, at page 15, lines 7-8, the Applicant provides that “the concepts [and thus the instruments associated with the concepts] can be valued in many different ways, based on various possible parameters.” Similarly, at page 22, line 22 to page 23, line 2, the Applicant provides that there are “[m]any different ways to gauge or determine the value of a concept . . . in various embodiments of the invention, including different measures, statistics, indexes, quantities, variables, and the like.” Instrument valuation is therefore not an essential element of the invention and the claims are not incomplete for omitting such elements from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1-39 are pending in the above-identified application. In the Office Action dated January 25, 2005, the Examiner rejects claims 1-4, 9-15, 20-21, 25, 28-31, and 33-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,233 (Rubenstein) in view of U.S. Patent Pub. 2002/0138445 (Laage *et al.*), claims 5-8, 17-19, 22-24, 26-27 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Rubenstein and Laage further in view of U.S. Patent No. 5,794,233 (Davis *et al.*), and claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Rubenstein and Laage further in view of U.S. Patent Pub. No. 2002/0091621 (Conklin *et al.*). The Applicant respectfully traverses the rejections, and asserts that the claims pending in the present application, *i.e.*, claims 1-39, are patentable over Rubenstein, Laage, Davis, and Conklin for at least the reasons stated below.

Rubenstein discusses a method for identifying documents stored in a computer readable medium by automatically identifying keyword phrases in the documents, prompting

5598-9

Serial No.: 10/625,082

the user to construct a query which includes at least one of the keyword phrases, and identifying documents based on the query expression. Col. 2, lines 35-59. Laage discusses a process by which owners of payment instruments control the usage of payment instruments by allowing the owners to selectively block and unblock the payment instruments. Paragraph 0017. Davis discusses a system and method for enabling a web site promoter to influence a position within a search result list generated by an Internet search engine. Col. 4, lines 51-55. Conklin discusses methods for an issuer of financial instruments to model the instruments with initial financial parameters for actual issuance in a primary offering. Paragraph 0009.

In contrast, claims 1, 32, 33, 35, and 36, and the claims dependent thereon, provide a computer implemented method, networked computer systems, and a computer readable medium, that allow for transactions in instruments that are valued based on the value of one or more concepts that the instrument is associated with. None of the references cited by the Examiner disclose or suggest any instruments valued based on associated concepts and any transactions in such instruments.

The Examiner asserts that Rubinstein discloses concepts, Laage discloses instruments for a transaction, and it would have been obvious to modify Rubenstein based on the teachings of Laage and that the motivation to combine these references is to enhance effectiveness and efficiency of transactions based on terms that combine to equal a concept. The Applicant respectfully disagrees. As noted above, Rubenstein discusses methods for identifying documents stored in a computer readable medium by automatically identifying keyword phrases in the documents and identifying documents based on the query expression. Col. 2, lines 35-59. Results may be assigned a relevance code based on grammatical and definitional significance. Col. 6, lines 52-56. Laage discusses methods for protecting payment instruments, such as credit card or the like, by selectively blocking payment. Paragraph 0043. There is no motivation either expressly stated in the references or known to those skilled in the art to modify or combine these references, nor do these references combine to allow transactions in instruments valued based on the concepts that the instruments are associated with in accordance with the present invention. Moreover, the motivation proffered by the Examiner does not appear to be well founded. Keyword phrases and relevance codes in accordance with Rubenstein do not enhance the effectiveness and efficiency of credit card transactions in accordance with Laage. Indeed, Rubenstein and Laage are directed toward non-analogous fields, *i.e.*, document search technology *vs.* credit

5598-9
Serial No.: 10/625,082

card protection, and one skilled in the art would not be inclined to combine the non-analogous art.

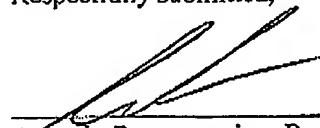
In order to establish a prima facie case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP 2143.01. Since the Examiner did not cite any reference for the motivation referred to above, as well as for the motivation to combine the other references of record, it appears that the Examiner is taking official notice that such motivations are based on common knowledge available to one of ordinary skill in the art. To the extent this is true, the Applicant traverses the Examiner's taking of official notice and demands that the Examiner produce documentary evidence for each of the stated motivations for rejecting claims 1-39. "Official notice ... should only be taken by the examiner where the facts asserted to be well-known, or in common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP 2144.03A. This is not the case with the motivations asserted by the Examiner for rejecting claims 1-39 of the present application.

The other dependent claims are patentable for additional reasons. While deemed unnecessary to argue these additional reasons at this time, given the arguments presented above, the Applicant reserves the right to present such arguments should it become necessary or desirable to do so.

5598-9
Serial No.: 10/625,082

For the above reasons, the Applicant submits that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 1-39 are respectfully solicited. The Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

Respectfully submitted,

Date: May 27, 2005
Antonio Papageorgiou, Reg. No. 53,431
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Telephone No. 212-895-2905
Facsimile No. 212-895-2900

I hereby certify that this paper and any accompanying papers referenced herein are being transmitted by Facsimile to the USPTO 703-872-9306 or deposited this date with the U.S. Postal Service as First Class Mail with sufficient postage addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Antonio PapageorgiouMay 27, 2005
Date